

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH L. CHAVES

Appeal No. 97-2440
Application 29/036,036¹

ON BRIEF

Before LYDDANE, METZ and KRASS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

¹Application for patent filed March 10, 1995. According to appellant, the application is a division of Application 07/920,149 filed July 24, 1992, now U.S. Patent No. D 356,213 granted March 14, 1995.

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This design application is on appeal from the final rejection of the only claim pending.

The subject matter of the invention is an ornamental design for a pipe fitting cleaner brush. Although Figures 4 and 5 of the application show the pipe fitting cleaner brush inserted in an electric screwdriver, the screwdriver is not part of the ornamental design on which protection is sought. This is made clear from the preliminary amendment of March 10, 1995 (Paper No. 2) which amends the figure description to read "The electric screwdriver is shown in dotted lines and is not part of the design as claimed." An appropriate substitute drawing, consistent with this amendment, was also filed therewith.

The examiner relies on the following reference:

Lawrence	4,850,071	Jul. 25, 1989
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The following reference is relied on by the Board:

Chaves	Des. 356,213	Mar. 14, 1995 (filed Jul. 24, 1992)
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The appealed claim stands rejected under 35 U.S.C. 103 as unpatentable over Lawrence.

The examiner states, at page 3 of the answer:

The overall appearance of the claimed design is substantially shown by the circular brush of Lawrence (FIG. 2, elements 12, 14, and 20), with the major visual difference residing in the fact

that the wire stem (12) is completely twisted.

It would have been obvious...to modify Lawrence by untwisting the stem (12) begining [sic, beginning] below the bristles to create a contrasting appearance in the stem. This modification would meet the overall appearance of the claimed design.

A fundamental element necessary to support the rejection of a claimed design under 35 U.S.C. 103 is that "there must be a reference, a something in existence, the design characteristics of which are basically the same as the claimed design..." In re Rosen, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

Clearly, Lawrence is a Rosen-type reference with regard to the instant claimed subject matter. They both relate to pipe fitting cleaning brushes having circular cleaning brushes on one end with a twisted wire stem leading therefrom and a hexagonal shaft on the other end for insertion into an electrical power tool². Thus, the issue before us is whether it would have been obvious, within the meaning of 35 U.S.C. 103, to modify the design of the Lawrence pipe fitting cleaning brush in such a way as to arrive at the instant claimed design.

²This functional use of the hexagonal shaft is of no moment in consideration of the ornamental design before us.

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In considering the patentability of a design, it is the overall appearance, the visual effect as a whole of the design, which is taken into consideration. In re Leslie, 547 F.2d 116, 120, 192 USPQ 427, 429 (CCPA 1977). The proper standard of review under 35 U.S.C. 103 is whether the claimed design would have been obvious to a designer of ordinary skill involved with the type of article with which the claimed design is concerned. In re Nalbandian, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981).

Appellant contends that the design features of a. a rounded tip at the end of the brush, b. a short length of the hexagonal base of the brush, c. the inward tapered elongated thinner polygon length between the top of the base and the start of the twisted wire portion of the brush; and d. the flat smooth bottom end portion of the base, all serve to patentably distinguish the claimed design from what is shown by Lawrence.

The examiner contends [answer, pages 4-5] that the differences in the appearances of the top of the twisted wire and the bottom of the hexagonal base are so minor that they do not impact on the overall appearance of the claimed design. Further, the fact that the hexagonal shaft of the claimed design is shorter than that of the applied reference is an obvious variation which involves ordinary skill.

While we might agree with the examiner's observations with regard to the top of the twisted wire, the bottom of the base and the length of the hexagonal shaft, taken individually, when these individual features are viewed as a whole, there appears to be a visual impact which results in an ornamental design quite different from that of Lawrence. But, in any event, once the portion between the twisted wire portion and the top of the hexagonal base is taken into account, it is our view that the overall design of the instant claim is of such substantial difference with regard to that shown by Lawrence as to be patentably distinct therefrom. Whereas Lawrence's brush constitutes a continuous twisted wire from the top of the hexagonal base to the brush section, the instant claimed design comprises a substantial length of an untwisted portion (called a "polygon" section by appellant) between the top of the hexagonal base and the twisted portion leading to the brush section.

When considering the cumulative effect of these differences in design, it is our view that the instant claimed design patentably distinguishes over the Lawrence design and the examiner's contentions that it "would have been obvious...to modify Lawrence by untwisting the stem (12) beginning [sic, beginning] below the bristles to create a contrasting appearance

in the stem" and that this "modification would meet the overall appearance of the claimed design" (answer, page 3) constitute impermissible hindsight. There is absolutely no evidence of record, other than appellant's own teaching, as to why the skilled designer of pipe fitting cleaner brushes would have been led to modify Lawrence's design by untwisting the stem beginning below the bristles in order to create a contrasting appearance in the stem.

The examiner's observation that column 2, line 39 of Lawrence suggests that the stem may constitute a single rod rather than a twisted portion is unpersuasive since Lawrence does not show such an alternative embodiment and it is not clear what the design of such an embodiment would look like. As we read that section of Lawrence, the alternative embodiment would constitute a straight rod from the top of the hexagonal base to the brush section with a twisted wire portion forming no part thereof. Therefore, even this disclosed alternative embodiment of Lawrence would fail to show or suggest the overall design of the instant invention including a straight portion intermediate the top of the hexagonal base portion and the twisted wire portion leading to the brush section.

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Accordingly, we will not sustain the examiner's rejection of appellant's design claim under 35 U.S.C. 103.

NEW GROUND OF REJECTION UNDER 37 CFR 1.196(b)

In accordance with 37 CFR 1.196(b), we make the following new ground of rejection.

The design claim is rejected under the judicially created doctrine of obviousness-type double patenting in view of the design claim of Design Patent No. D356,213 to Chaves.

While the claimed design of Chaves differs from the instant design claim in that the former includes the electric screwdriver as part of the overall design, the instant claimed design would have been obvious, within the meaning of 35 U.S.C. 103, in view of the pipe fitting cleaner brush portion of Chaves' design, which portion is identical in design to appellant's claimed brush design. While the instant claimed design is not identical, in overall appearance, to the Chaves design, the designer of ordinary skill would have found it obvious to remove the cleaner brush from the screwdriver in Chaves resulting in a cleaner brush design identical to that claimed.

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A properly filed terminal disclaimer would overcome this new ground of rejection on obviousness-type double patenting.

We have reversed the examiner's rejection of the design claim under 35 U.S.C. 103 and we have entered a new ground of rejection, based on obviousness-type double patenting, under 37 CFR 1.196(b).

Accordingly, the examiner's decision is reversed.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

REVERSED, 37 CFR 1.196(b)

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Administrative Patent Judge)	
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ANDREW H. METZ)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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